

ESTTA Tracking number: **ESTTA678297**

Filing date: **06/16/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Automattic, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	132 Hawthorne Street San Francisco, CA 94107 UNITED STATES		

Correspondence information	Mary L. Shapiro Mary L. Shapiro Law, PC 244 California Street, Suite 507 San Francisco, CA 94111-4354 UNITED STATES iplaw@maryshapiro.com Phone:415-398-3141
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Registrations Subject to Cancellation

Registration No	4010482	Registration date	08/09/2011
Registrant	Pearson, Chris PO Box 5429 Austin, TX 787635429 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2008/03/29 First Use In Commerce: 2008/03/29 All goods and services in the class are cancelled, namely: Web site development software
Class 042. First Use: 2008/03/29 First Use In Commerce: 2008/03/29 All goods and services in the class are cancelled, namely: Computer software installation and maintenance; Technical support services, namely, troubleshooting of computer software problems; Web-site design and development for others

Grounds for Cancellation

The mark is merely descriptive	Trademark Act section 2(e)(1)		
Other	The subject registration was issued to an individual rather than the corporation, notwithstanding that the corporation was established prior to the application being filed and the corporation is the party using the mark		
Registration No	4061171	Registration date	11/22/2011
Registrant	Pearson, Chris PO Box 5429 Austin, TX 787635429 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2008/03/29 First Use In Commerce: 2008/03/29 All goods and services in the class are cancelled, namely: Web site development software
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Grounds for Cancellation

The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)		
Other	The subject registration was issued to an individual rather than the corporation, notwithstanding that the corporation was established prior to the application being filed and the corporation is the party using the mark		
Registration No	4039583	Registration date	10/11/2011
Registrant	Pearson, Chris P.O. Box 5429 Austin, TX 787635429 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2008/03/29 First Use In Commerce: 2008/03/29 All goods and services in the class are cancelled, namely: Web site development software
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Grounds for Cancellation

The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	The subject registration was issued to an individual rather than the corporation, notwithstanding that the corporation was established prior to the application being filed and the corporation is the party using the mark

Attachments	Petition to Cancel Chris Pearson Marks 06122015.pdf(160055 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mary L. Shapiro/
Name	Mary L. Shapiro
Date	06/16/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: DIYTHEMES
Reg. No. 4010482
Registration Date: August 9, 2011

Mark: THESIS THEME
Reg. No. 4061171
Registration Date: November 22, 2011

Mark: THESIS
Registration No. 4039583
Registration Date: October 11, 2011

Automattic, Inc.

Petitioner,

v.

Chris Pearson

Registrant.

Cancellation No. _____
PETITION TO CANCEL

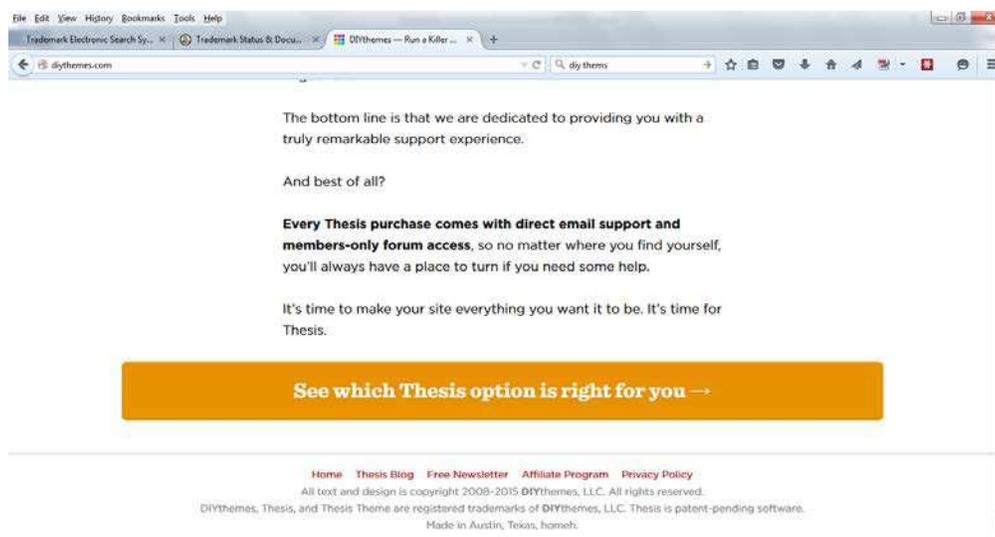
PETITION TO CANCEL

Automattic, Inc. (“Petitioner”), a corporation limited liability company, organized and existing under the laws of the State of Delaware, having a business address at 132 Hawthorne Street, San Francisco CA 94107, believes it is being or may be damaged by the continued registration of the alleged registrations, (1) DIYTHEMES, as shown in Registration No. 4010482, (2) THESIS THEME, as shown in Registration No. 4061171, and (3) THESIS, as shown in Registration No. 4039583 (collectively the “Pearson Registrations”), each in the name of Chris Pearson (“Registrant”), an individual, with a mailing address of P.O. Box 5429 Austin, TX 78763-5429. Petitioner hereby files this Petition for Cancellation.

As grounds for cancellation, Petitioner alleges:

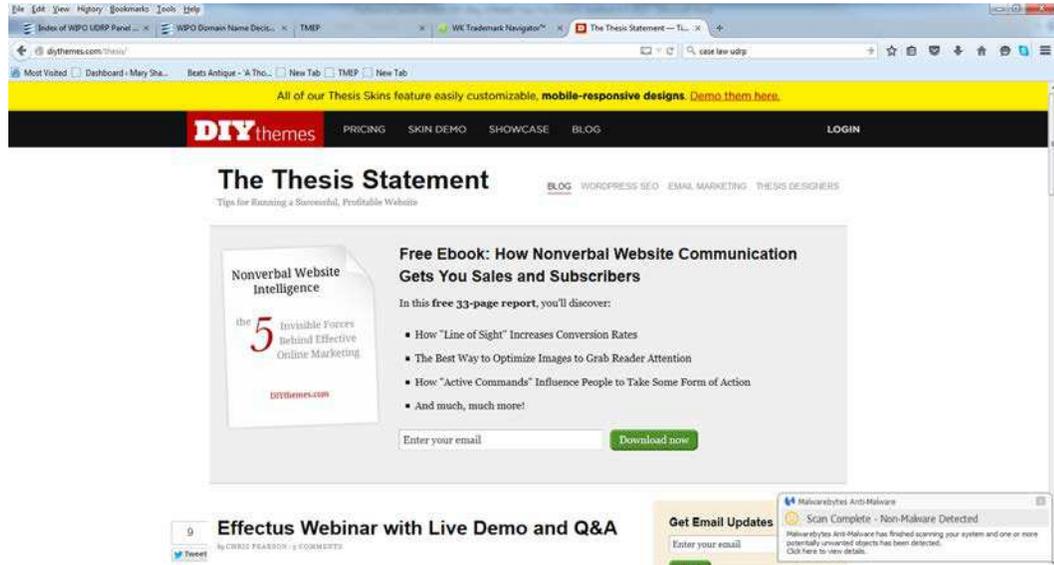
1. Individual Chris Pearson (“Mr. Pearson”) filed applications for the marks: (1) DIYTHEMES, the subject of Application No. 85126347 filed on September 9, 2010, (2) THESIS THEME, the subject of Application No. 85115266 filed on August 25, 2010, and (3) THESIS, the subject of Application No. 85113269 on August 23, 2010 (collectively the “Pearson Applications”).

2. The Pearson Applications were filed based on Mr. Pearson's alleged Intent to Use the marks DIYTHEMES, THEME THESIS, and THESIS.
3. Subsequently, Mr. Pearson claimed use in commerce at least as early as March 29, 2008 the marks DIYTHEMES, THEME THESIS, and THESIS.
4. Registrations issued to Mr. Pearson as follows: (1) DIYTHEMES, as shown in Registration No. 4010482, on August 9, 2011, (2) THESIS THEME, as shown in Registration No. 4061171 on November 22, 2011, and (3) THESIS, as shown in Registration No. 403958 on October 11, 2011.
5. The Pearson Registrations were obtained by an individual, Mr. Pearson.
6. The afore-referenced marks, which are the subject of this petition to cancel, are presently in use in commerce by DIY Themes LLC, and have been since 2008, as shown on the home page located at <http://diythemes.com/>, as shown below:



7. Ownership of the Pearson Registrations is attributed to the limited liability company DIY Themes LLC.
8. The entity DIY Themes LLC was formed on July 10, 2008, under the laws of the State of Texas, well before Mr. Pearson filed the Pearson Applications at the USPTO in 2011.
9. Under the laws of Texas, a limited liability company is treated as a separate and distinct entity from its members.
10. Applications filed under §1(b) of the Act, 15 U.S.C. §1051(b), must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date.
11. The Pearson Applications were improperly filed in the name of an individual, who did not have the requisite intent-to-use the marks as of the filing date, and the underlying applications are void ab initio.

12. Filing an application under an incorrect applicant name, as set forth herein, is an error that cannot be corrected by amendment (*Trademark Manual of Examining Procedure*, Section 1201.02) or assignment (*37 Code of Federal Regulations* §2.71(d)).
13. As of the filing of this Petition, the THESIS mark (Reg. No. 4039583) appears on a website in a descriptive manner at www.thesistheme.com/thesis, as shown below.



14. The term “thesis” is defined as both “a proposition stated or put forward for consideration, especially one to be discussed and proved or to be maintained against objections” and “a subject for a composition or essay.”
15. The term “thesis” is a synonym for a statement of a proposition, which results in an entirely descriptive use of the alleged mark shown above.
16. As presented on the afore-mentioned website, DIY Themes LLC is using the alleged THESIS mark descriptively by offering content that sets forth “Tips for Running a Successful, Profitable Website,” as a subject for an essay in the form of an e-book.
17. Registration of the THESIS mark (Registration No. 4039583) should not have been granted on the principal register absent a showing of secondary meaning.
18. Mr. Pearson has filed a Uniform Domain Name Dispute Resolution Policy proceeding, challenging ownership by Petitioner of the domain name <thesis.com>, which domain was acquired by Petitioner in 2014.
19. For each and every reason stated above, Petitioner believes that it will be damaged by continued registration and maintenance of Pearson Registrations as protested of herein.

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WHEREFORE, Petitioner prays that the petition to cancel Registration No. 4010482, Registration No. 4061171, and Registration No. 4039583 be granted under 15 U.S.C. § 1068 [Trademark Act § 18] and that the subject registrations be cancelled.

Respectfully submitted,

A handwritten signature in blue ink that reads "Mary L. Shapiro". The signature is written in a cursive style.

By:

Mary L. Shapiro, Esq.
Attorney for Automattic, Inc.

Dated: June 15, 2015

Mary L. Shapiro Law, PC
244 California Street, Suite 507
San Francisco, CA 94111-4354
Telephone: 415-398-3141
Email: iplaw@maryshapiro.com

PROOF OF SERVICE BY MAIL
C.C.P. 1013a

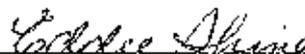
I declare that I am a resident of or employed in the County of San Francisco, California. I am over the age of 18 years and not a party to the within entitled cause. The name and address of the business at which I am employed is: Mary L. Shapiro Law, PC, 244 California Street, Suite 507, San Francisco, California 94111-4354.

I am readily familiar with the ordinary practice of the business of collecting, processing and depositing correspondence in the United States Postal Service and that the correspondence will be deposited the same day with postage thereon fully prepaid.

On June 15, 2015, I served the PETITION TO CANCEL on the parties listed below by placing a true copy thereof enclosed in a sealed envelope for collection and mailing in the United States Postal Service following ordinary business practices at San Francisco, California addressed as follows:

Mr. Chris Pearson
P. O. Box 5429
Austin, TX 78763-5429

I declare under penalty of perjury that the foregoing is true and correct and that this declaration was executed on June 15, 2015 at San Francisco, California.



Eddie Shine